

## REMARKS

Claims 50-52 are cancelled without prejudice and without disclaimer of the subject matter therein. Accordingly, Claims 35-49 and Claims 53-56 are pending.

### **I. Claims Rejected Under 35 U.S.C. § 103(a)**

The Examiner rejects Claims 35-56 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,797,089 to Nguyen ("Nguyen") in view of U.S. Patent No. 5,875,403 to Christal ("Christal"). Applicants respectfully traverse this rejection.

The Examiner's obligation in making a *prima facie* case of obviousness requires the Examiner to show that the prior art in combination teaches or suggests all elements of the claimed invention. Applicants respectfully submit that the Examiner has failed to set forth a *prima facie* case of obviousness.

Among other limitations, Claims 35, 44, and 47 recite automatically selecting a form for a message to be transmitted based on a content of the displayed information. Among other limitations, Claim 56 recites automatically selecting a message to be transmitted in response to the testing predetermined content.

In making the rejection, the Examiner relies on Nguyen to show that a user of the personal communications terminal can send a message by utilizing a text editor to edit a message. (Nguyen, col. 6, lines 25-27.) Christal discloses that a user may respond to a message received on a mobile telephone by pressing the soft key labeled "options," and then pressing a soft key labeled "yes" or "no." (Christal, col. 2, lines 23-47.) Thus, Nguyen nor Christal teach or suggest automatically selecting a form for a message to be transmitted based on a content of the displayed information since both require the user to manually create a response. For the same reason, neither

Nguyen nor Christal teach or suggest automatically selecting a message to be transmitted in response to detecting predetermined content.

Accordingly, Applicants respectfully request the withdrawal of the rejection of independent Claims 35, 44, 47, and 56. Claims 36, 37 and 43 depend from Claim 35. Claims 45 and 46 depend from Claim 44. Claims 48 and 49 depend from Claim 47. As such, the rejected dependent claims are not obvious for at least the same reasons as their respective independent claims.

Among other limitations, Claims 38 and 53 recite in response to detecting predetermined content, automatically entering the mode for allowing a user to transmit a message.

In making the rejection, the Examiner states that Nguyen does not specifically disclose the use of automatically entering a reply mode when a message is selected. (Office Action dated 11/7/01, pg. 3, paragraph 3.) The Examiner argues that Christal remedies this deficiency in Nguyen. As seen in Figure 4 of Christal, a user cannot reply to a message without first pressing a soft key labeled "options." Hence, Christal does not teach or suggest automatically entering a mode for allowing the user to transmit a message. Thus, neither Nguyen nor Christal teach or suggest in response to detecting predetermined content automatically entering a mode for allowing a user to transmit a message.

Accordingly, Applicants respectfully request the withdrawal of the rejection of independent Claims 38 and 53. Claims 39-42 depend from Claim 38. Claims 54-55 depend from Claim 53. As such, the rejected dependent claims are not obvious for at least the same reasons as their respective independent claims.

## II. Double Patenting

The Examiner rejects Claims 35-56 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-14 of U.S. Patent No. 6,169,911 to Wagner, et al. ("Wagner"). Claims 50-52 are cancelled without prejudice and without disclaimer of the subject matter disclosed therein.

To establish a *prima facie* case of non-statutory type double patenting, the Examiner must show that any variation between the inventions in the claims under consideration and the earlier issued patent's claims would have been obvious to a person of ordinary skill in the art.

In making this rejection, the Examiner argues that although the conflicting claims are not identical, they are not patentably distinct from each other because the added feature of an automatic reply technique specifically being machine implemented does not render the aforementioned claims patentably distinct from Claims 1-14 of Wagner.

Applicants argue that the Examiner has failed to state a *prima facie* case of non-statutory double patenting.

Among other limitations, Claims 38 and 53 recite in response to detecting predetermined content, automatically entering a mode for allowing a user to transmit a message. In Wagner, Claims 1-10 and 12-14 recite in response to user input, automatically entering either an electronic mail reply mode or a voice reply mode. Since Wagner requires that the user provide input to enter a reply mode, Wagner does not teach or suggest automatically entering a reply mode in response to detecting predetermined content.

Accordingly, Applicants respectfully request the withdrawal of the rejection of independent Claims 38 and 53. Claims 39-42 depend from Claim 38. Claims 54-55 depend from Claim 53. As such, the rejected dependent claims are not obvious for at least the same reasons as their respective independent claims.

Among other limitations, Claims 35, 44, 47, and 56 recite automatically selecting a form for a message to be transmitted based on a content of the displayed information. In Wagner, Claim 11 recites automatically selecting and displaying on the display device a reply form having predetermined, non-address content appropriate for the sender of the selected message in response to the user input. Since Wagner discloses that a reply form is chosen automatically in response to user input rather than based on a content of the displayed information, Wagner does not teach or suggest such.

Accordingly, Applicants respectfully request the withdrawal of the rejection of independent Claims 35, 44, 47 and 56. Claims 36, 37, and 43 depend from Claim 35. Claims 45 and 46 depend from Claim 44. Claims 48 and 49 depend from Claim 47. As such, the rejected dependent claims are not obvious for at least the same reasons given for their respective independent claims.

CONCLUSION

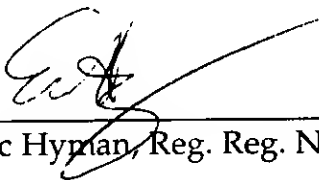
If necessary, the Commissioner is hereby authorized, in this, concurrent and future replies, to charge payment or credit any other payment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: February 7, 2002

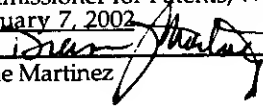
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on February 7, 2002

  
Diane Martinez

2/7/02

Date